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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/925,122	08/08/2001	Olga Bandman	PF-0419-2 DIV	7383

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EXAMINER	
FRONDA, CHRISTIAN L	
ART UNIT	PAPER NUMBER
1652	5

DATE MAILED: 02/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/925,122	Bandman et al.
Examiner	**Art Unit**
Christian L. Fronda	1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-5, 7-15, 17, 20, and 23-26* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☐ Claim(s) _____ is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☒ Claims *1-5, 7-15, 17, 20, and 23-26* are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-3, 14, and 15, drawn to an isolated polypeptide comprising an amino acid sequence of SEQ ID NO: 1 and SEQ ID NO: 3, classified in class 530, subclass 350.

II. Claims 4, 5, 7, 9, and 10, drawn to an isolated polynucleotide, host cell, and method for producing a polypeptide, classified in class 435, subclass 69.1.

III. Claim 8, drawn to an antibody, classified in class 530, subclass 387.1.

IV. Claims 11 and 12, drawn to a method for detecting a target polynucleotide in a sample comprising hybridizing the sample with a probe comprising at least 20 contiguous nucleotides, classified in class 435, subclass 6.

V. Claims 13, drawn to a method for detecting a target polynucleotide in a sample comprising amplifying said target polynucleotide using polymerase chain reaction amplification, classified in class 435, subclass 91.2.

VI. Claim 17, drawn to a method for screening a compound for effectiveness as an agonist of a compound, classified in class 514, subclass 2.

VII. Claim 20, drawn to a method for screening a compound for effectiveness as an antagonist of a compound, classified in class 424, subclass 130.1.

VIII. Claim 23, drawn to a method for screening for a compound that specifically binds to a polypeptide, classified in class 435, subclass 7.1.

IX. Claim 24, drawn to a method for screening for a compound that modulates the activity of a polypeptide, classified in class 435, subclass 7.1.

X. Claim 25, drawn to a method for screening a compound for effectiveness in altering expression of a target polynucleotide, classified in class 514, subclass 44.

XI. Claim 26, drawn to a method for assessing toxicity of a test compound, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Groups I-III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of Groups I-III are independent chemical entities and require different literature searches.

Inventions of Groups IV-XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the processes of Groups V-VIII are distinct both physically and functionally, have different purposes, and require different process steps, reagents, and parameters.

Inventions of Groups I and III are unrelated to the processes of Groups IV-IX and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Each of the processes of Groups IV-IX and XI do not require the products of Groups I and III.

Inventions I and (VI-IX) are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the polypeptide in a process to make antibodies to the polypeptide.

Inventions II and X are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product as claimed can be used in a materially different process of using that product such as using the polynucleotide in a recombinant process to make a polypeptide.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. The claims are generic to a plurality of disclosed patentably distinct species. Applicants are required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement

is traversed.

For each of Groups I-XI, the species are each of the sequences of SEQ ID NOs: 1-4. If any one of Groups I-XI is elected, then Applicants must elect only one sequence for examination.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christian L. Fronda whose telephone number is (703)305-1252. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703)308-3804. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1600 receptionist whose telephone number is (703)308-0196.

A response to this Office Action may be faxed directly to the Examiner whose Fax Number is (703)746-5036 in order to expedite prosecution.

CLF

PONNATHAPU ACHUTAMURTHY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600